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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :

GARRISON et al. : Group Art Unit: 3623

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Serial No. 08/994,047 : Examiner: A. Boyce

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Filed: December 19, 1997 :

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GROUP 3600

For: AN ELECTRONIC BILL PAYMENT SYSTEM WITH MERCHANT
     IDENTIFICATION

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450   October 20, 2003

Sir:

This Reply Brief is submitted in response to the Examiner's Answer issued on

July 18, 2003.

The Examiner responds to the arguments presented in the Appeal Brief in

Section 11 (on pages 13-16) of the Examiner's Answer.

In the first paragraph of the Response, the Examiner asserts that "It should be

noted that the previous rejection was based on the premise that this hash code [the

hash code described by Haimowitz] was no different in substance than an eleven digit

zip code because the hash code, in effect, contained the same information as that of

an eleven-digit zip code, which includes the name, city, state and zip code". It is also

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asserted that "as explained in the rejection, the hash code of Haimowitz is no different in substance than an eleven-digit zip code since they both contain the same type of information (e.g., five-digit zip code + delivery sector + building number) and generated in the manner recited. Even though Haimowitz does not specifically mention an 11-digit zip code, the content and the function of the hash code matches that of the 11-digit zip code" (see paragraph bridging pages 13-14).

As understood, the Examiner acknowledges that Haimowitz hash code is generated using only a name, city, state and 4 digit 5 zip code. Furthermore, the Examiner acknowledges that an 11-digit zip code is formed using a 5-digit zip code (representing the post office location) plus 4 digits representing a delivery sector + 2 digits of the building number (i.e., the last 6 digits represent the street address). Indeed, as detailed by the Examiner in the Official Action dated August 16, 2002, and described in an article entitled "History of the U.S. Postal Service", which is available at the USPS web site, the 4 digits of the zip code for the delivery sector correspond to a street and the last 2 digits of an 11-digit zip code correspond to digits of the applicable building number on that street.

Accordingly, the Examiner's assertion that the Haimowitz hash code is no different in substance than the required 11-digit zip code is a *non-sequitur*. That is, since Haimowitz generates the hash without considering the street address (as acknowledged in the final Official Action and the Examiner's Answer), it cannot be "no different in substance than an eleven-digit zip code" (which the final Official Action and Examiner's Answer acknowledge to require a street address).

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Indeed, the Examiner's assertion is logically flawed. Since Haimowitz does not even include a street name within its hash code, Haimowitz hash code is at best no different in substance than a 5-digit zip code. Therefore, based on the Examiner's own assertions and understanding of the USPS zip code system, there is necessarily a material difference in substance between the Haimowitz hash code and an 11-digit zip code. Furthermore, in view of this acknowledged difference, there is no support for the Examiner's assertion that "the content and the function of the hash code matches that of the 11-digit zip code", and thus there is no prima facie basis for the rejection.

In the paragraph bridging pages 14 and 15 of the Examiner's Answer, it is argued that "[e]ven though there is no recitation of any steps related to actually effectuating payment, as described in the previous Office Action, the fact that the records are directed to a "payee" is not patentably significant since the records possession (i.e., to "whom" the data belongs) does not confer patentable weight to the underlying process".

The Examiner fails to site any support for the asserted conclusion. Furthermore, contrary to the Examiner's contention, all words in a claim must be considered in deciding the patentability of the claim against the prior art. See in re Wilson, 165 USPQ 494 (CCPA 1970), and In re Oelrich, 212 USPQ 323 (CCPA 1981).

Accordingly, the acknowledged failure to consider an express limitation of claims 1, 11 and 16, further evidences the lack of a prima facie basis for the rejection.

More particularly, each of claims 1, 11 and 16 requires that a payor's payment

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information be received and processed to locate a payee record.

Steps relating to an actual effectuating of payment are not claimed, and accordingly are irrelevant to the invention being claimed by the inventors in the present application. However, it is material to the present invention that a certain type of information (i.e., a payor's payment information) is what must be processed in accordance with claims 1, 11 and 16 to locate another type of information (i.e., a payee record). Accordingly, this limitation must be given patentable affect.

In the first full paragraph on page 15 of the Examiner's Answer, it is argued that Haimowitz teaches receiving new customer records in column 3, lines 48-53, which include a zip code, and "then goes on to teach that a zip code is generated from the address information if the zip code is missing or incorrect" (emphasis added), citing column 3, lines 65-67, column 4, lines 6-14 and 42-51, and column 5, lines 1-3.

However, although the Examiner asserts that a zip code is generated from the address information, if a zip code included in the address information is incorrect, the only cited section of Haimowitz which describes the handling of address information that includes an incorrect zip code, is in column 4, lines 42-51. As described therein "if part of the postal code (zip code relates to U.S. addresses and postal code relates to International addresses) can not be used as a hash key, then the data is bad and is placed into a "bad data" file for future resolution. The rules for insertion into the bad data file, are as follows: ... 3 "in the U.S.: no zip code and can not derive the zip from city and state" (emphasis added).

The examiner appears to have ignored the description in column 3, lines 10-15,

wherein Haimowitz discloses that for validation, the fields in each record are checked

for quality. Only if the data is good is a hash key for that data selected. In column 4,

lines 11-14, it is further disclosed that the verification process functions to use a zip

code table (obtained from the USPO-see column 3, lines 66-67) to verify a received

city and state based on a received zip code. If a city and state without a zip code are

received, then the zip code can be dubbed.

It should be noted that because the city and state are verified using a received,

zip code, if a city, state and zip code are received but there is an inconsistency

between the received city and state and the received zip code, Haimowitz has no way

of determining whether the error is in the received city and state or in the received zip

code. Accordingly, Haimowitz does not suggest that a zip code can be dubbed or

derived in cases where such an inconsistency exist. Rather, Haimowitz explicitly

discloses that a zip code is only dubbed or derived, if a city and state are received

with no zip code.

As further disclosed in column 4, lines 37-39, if the received data in the fields are

bad (i.e., cannot be verified), then the record is removed from further consideration

and placed in the pending file 22.

It is noted that in explaining Rule 3 for insertion into the bad data file (see column

4, lines 55-58), Haimowitz states that the data will be placed in the bad data file if

there is no zip code or the zip code cannot be derived from the city and state. As

discussed above, in the case of an inconsistency between a received city and state

and received zip code, the zip code can not be derived from the city and state,

because Haimowitz has no way of knowing whether the received city and state or the received zip code are incorrect. Furthermore, Haimowitz explicitly discloses that the zip is derived only if a city and state are received without a zip code. Accordingly, if the received zip coded is incorrect, Haimowitz teaches placing the received data in the bad data file.

Hence, the Examiner fails to rebut the traversal arguments set forth in the Appeal Brief in the paragraph bridging pages 16 and 17, and the paragraph bridging pages 18 and 19, as well as in the paragraphs beginning with the first full paragraph on page 22 and continuing through the last full paragraph on page 23, and beginning with the third full paragraph on page 27 through the first full paragraph on page 30. Thus, the assertion that Haimowitz generates a hash code (which the Examiner incorrectly contends to correspond to the claimed zip code) from received address information which excludes a received zip code (i.e., a received incorrect zip code) is not supported by that which is disclosed by Haimowitz. Indeed, such a construction is inconsistent with that which is explicitly taught by Haimowitz (i.e., that if received address information includes an incorrect zip code, it is set aside in a bad data file and therefore not used to generate a hash code). Thus, here again, no prima facie basis for the asserted rejection has been established.

In the paragraph bridging pages 15 and 16 of the Examiner's Answer, it is argued that Haimowitz's disclosed normalization is equivalent to the required altering of the payor account number according to alteration rules corresponding to or associated with the payee as required by claims 8, 14, 20 and 23. In support, the Examiner

relies on the Haimowitz disclosure in column 3, lines 54-60. However, the referenced the disclosure is unrelated to Haimowitz's normalization, which is described in column 4, lines 20-36. Hence, the Examiner's conclusion is unsupported by the relied upon disclosure.

Furthermore, each of claims 8, 14, 20 and 23 require that an account number be altered according to alteration rules corresponding to a particular payee whose zip code is identified. On the other hand, what Haimowitz discloses in column 4, is that all the received data is always normalized to the same standard, irrespective of which entity might be identified by that data or a corresponding hash code within a particular database.

That is, in accordance with the present invention, received data is processed to locate different payee records in the same database and also, in accordance with claims 8, 14, 20 and 23, to alter a received payor account number with the payee in accordance with alteration rules for that payee. Haimowitz on the other hand teaches the processing of the received data to identify an entity record within a particular database, and to alter the received data according to a single set of normalization rules for the database (i,e., not rules for the particular entity).

Hence, the rejection of claims 8, 14, 20 and 23 ignores explicit limitations required by the claims. Accordingly, no prima facie basis for the rejection has been established.

Furthermore, the Examiner asserts that "What was cited by the Examiner was that Haimowitz teaches the 'normalization' of the record (i.e., standard formatting),

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can be applied to different databases (i.e., different for a general business database as to a hospital database, of which is shown in column 3, lines 54-60). In this case 'different' relates to a wide variety of single databases and not multiple databases".

Here again there appears to be a *non-sequitur* in the Examiner's rationale. In one statement, the Examiner acknowledges that Haimowitz teaches that each different normalization format is applied to a different one of the databases (i.e., only one normalization format applies to each database), yet in another statement, the Examiner asserts that the term "different" in the phrase "different databases" relates to "a wide variety of single databases and not multiple databases". The assertions are not understood.

If the Examiner contends that Haimowitz discloses the use of different normalization standards for different databases, it fails to anticipate or make obvious different alteration rules with respect to data associated with the same database. On the other hand, if the Examiner is arguing that Haimowitz discloses the use of the same normalization rules for information within multiple different databases, then the required different alteration rules and single database are lacking.

We turn now to the penultimate paragraph on page 16 of the Examiner's Answer. The Examiner states that the asserted correspondence of the claimed remittance centers to "the financial institutions is not an unreasonable claim construction". However, the Examiner then asserts that "[r]eading the claims in this light, corporate payees usually have more than one financial institution accounting for received payments, whether the institution is a third party bank or an in-house accounting

department". However, the phrase "financial institutions", as well understood in the art, would not include "an in-house accounting department". Accordingly, the Examiner's assertions are not understood.

Furthermore, the Examiner goes on to state that "All electronic or physical payments are routed to the appropriate financial institution designated by the payee. Examiner's Official Notice was based on this fact and therefore it would have been obvious for one with ordinary skill in the art to route the payments to the correct financial institution for payment".

Even accepting the Examiner's proposed construction of the recited "remittance centers" as corresponding to "financial institutions" (although this would be entirely inconsistent with the specification and the commonly understood meaning of these phrases in the art), according to the Examiner's rational, it would only have been obvious to route payments to a financial institution (which according to the Examiner corresponds to a remittance center) which has been designated by the payee. Furthermore, the Examiner's contention that remittance centers and financial institutions are corresponding entities is nothing more than baldly asserted conclusion for which the Examiner (notwithstanding prior request to do so) has failed to identify any support.

If one were to accept, for purposes of argument, the Examiner's assertion that the financial institution could be an in-house accounting department, according to the Examiner's rational, it would only have been obvious to route the payments to the payee designated in-house accounting department.

However, this is not what is claimed. The Examiner has apparently ignored limitations of claims 9, 15, 21 and 24, all of which require the processing of an account number included in the received payment information to identify one of a plurality of remittance centers for directing the payment.

In either case, there is no need for the identification of the remittance center, as required in claims 9, 15, 21 and 24.

The Examiner's continued failure to address the traversal arguments set forth beginning with the paragraph bridging page 24 and 25 through the paragraph bridging pages 25 and 26, further evidences the lack of evidence to establish a prima facie basis for the rejection of these claims.

In summary, the rejection ignores express limitations recited in the claims, is based on a construction of the claims which is inconsistent with the common and ordinary meaning of the terms as would be understood by those skilled in the art, requires construction of the applied prior art in the manner inconsistent with its own teachings, and asserts a rationale for which there is no support within the applied prior art and which logically does not support the conclusions that it is alleged to support. The continued failure to address specific issues raised in the traversal arguments presented in the Appeal Brief, further evidences the lack of objective support within the applied art, or a reasonable rational, for the rejections.

In view of the positions being taken, and the evidence which has been asserted in support thereof, it is respectfully submitted that the claims patentably distinguish over the art. Accordingly, reversal of the final rejection of the claims is in order, and
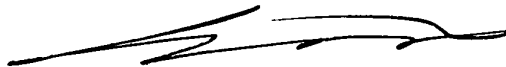
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such reversal is courteously solicited.

To the extent necessary, Applicants petition for an extension of time under 37

CFR § 1.136. Please charge any shortage in fees due in connection with the filing of

this paper, including extension of time fees, to the Deposit Account No. 01-2135

(Case No. 1158.41320X00) and please credit any excess fees to such Deposit Account.

Respectfully submitted,

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